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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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DINH, T	
ART UNIT	PAPER NUMBER

2841  
DATE MAILED:

10/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/543,011

Applicant(s)

WASHINO ET AL.

Examiner

Tuan T Dinh

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-30 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 13, and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, and 13, lines 2-5, it is unclear. The phrase of "one of the first locking member and the second locking member...the locking claw is engaged" is not understood.

Do the first locking member includes a locking claw and another of first locking member includes the engaging hole?

Do the second locking member includes a locking claw and another of second locking member includes the engaging hole?

Claim 23 recites the limitation "a guiding portion" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "said guiding portion" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 21, and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Cox et al (U. S. Patent 6,191,950 B1).

As to claims 1 and 25, Cox discloses a frame kit and an IC card (9, column 2, line 61) as shown in figures 2-3 comprising:

a frame (26, column 2, line 61) for defining an internal space (34, column 4, line 3) of an IC card (9);

a first panel (14, column 2, line 64) integrated with the frame (26) having a first locking member (23, 23', column 3, line 16) which includes a portion that is implanted (28-figure 3) and held in the frame, where a front end of the first locking member projects out from the implanted portion (28) toward the internal space (34) from an inner wall of the frame (see figure 2); and

a second panel (10, column 2, line 63)) having a second locking member (16, column 2, line 65) which is engageable with the first locking member (23) of the first panel inside the frame.

As to claims 2 and 26, Cox discloses a frame kit and an IC card as shown in figures 2-3 wherein the first panel is integrated with the frame by simultaneous molding (column 2, lines 5-7).

As best understood to claims 3, and 27, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the first locking member has a locking claw (see figure 3) engaging to the hole (22) of the second locking member.

As to claim 4, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the second locking member is composed of an elastic member (see figure 3).

As to claims 5 and 28, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein edges of the first panel and the second panel are contained in the frame.

As to claims 7 and 29, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the frame has an outer surface exposed toward an outside of the IC card (see figure 2) to form a side surface in a direction in which the IC card is inserted.

As to claims 8 and 30, Cox discloses a frame kit and an IC card as shown in figure 1 wherein an erroneous-insertion-preventing key (108-figure 1, column 1, line 36) is prevented the IC card when inserted in a wrong posture into an IC card slot forming on the outer surface of the frame. The first panel is integrated with the frame in a state where an area where the erroneous-insertion-preventing key is formed is ensured.

As to claim 21, Cox discloses a frame kit as shown in figure 1 wherein said key has a width differs along an outer surface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-18, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. (U. S. Patent 6,191,950).

As to claims 11, 16, and 23, Cox discloses a frame kit and an IC card (9, column 2, line 61) as shown in figures 2-3 comprising:

a frame (26, column 2, line 61) for defining an internal space (34, column 4, line 3) of an IC card (9);

a first panel (14, column 2, line 64) integrated with the frame (26) having a first locking member (23, 23', column 3, line 16) which includes a portion that is implanted (28-figure 3) and held in the frame, where a front end of the first locking member projects out from the implanted portion (28) toward the internal space (34) from an inner wall of the frame (see figure 2);

a second panel (10, column 2, line 63)) having a second locking member (16, column 2, line 65) which is engageable with the first locking member (23) of the first panel inside the frame; and

a circuit board assembly (12) being contained between the first and second panels (10, 14) constructed by mounting a connector (44) on the circuit board.

Cox does not disclose the second locking member comprising a guide portion extending obliquely toward an internal space.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the guide portion extending obliquely as taught by Cox in order to protect a circuit board against abnormal vibration or shock.

As to claim 12, Cox discloses a frame kit and an IC card as shown in figures 2-3 wherein the first panel is integrated with the frame by simultaneous molding (column 2, lines 5-7).

As best understood to claim 13, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the first locking member has a locking claw (see figure 3) engaging to the hole (22) of the second locking member.

As to claim 14, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the second locking member is composed of an elastic member (see figure 3).

As to claim 15, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein edges of the first panel and the second panel are contained in the frame.

As to claim 17, Cox discloses a frame kit and an IC card as shown in figures 2 and 3 wherein the frame has an outer surface exposed toward an outside of the IC card (see figure 2) to form a side surface in a direction in which the IC card is inserted.

As to claim 18, Cox discloses a frame kit and an IC card as shown in figure 1 wherein an erroneous-insertion-preventing key (108-figure 1, column 1, line 36) is prevented the IC card when inserted in a wrong posture into an IC card slot forming on

the outer surface of the frame. The first panel is integrated with the frame in a state where an area where the erroneous-insertion-preventing key is formed is ensured.

As to claim 22, Cox discloses a frame kit as shown in figure 1 wherein said key has a width differs along an outer surface.

As best understood to claim 24, Cox discloses a frame kit as shown in figures 2-3 wherein the second locking member further comprising a guiding portion (see figure 3) having an engaging hole (22).

Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Feldman (U. S. Patent 5,548,483).

As to claims 9-10 and 19-20, Cox discloses all of the limitations of the claimed invention, except for a second panel having a positioning member, which is elastic abutted against an inner wall of the frame for positioning the second panel with respect to the frame.

Feldman shows a frameless IC card (10) as shown in figures 10-115 comprising a second panel (42) having a positioning member (110), which is elastic abutted against an inner wall (104).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the frame kit of Cox and provide the positioning member as taught by Feldman in order to engage to a frame of a IC card.



***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 7-30 have been considered but are moot in view of the new ground(s) of rejection.

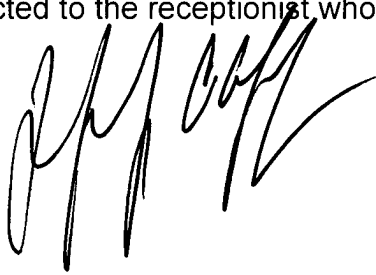
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Onoda, Kilmer et al., and Dye disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3431 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A handwritten signature in black ink, appearing to be 'Tuan T Dinh', is written over the signature line.

TD  
October 5, 2001